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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,788	07/30/2003	Jean Taylor	0573-1004-1	9395

466 7590 07/15/2009
YOUNG & THOMPSON
209 Madison Street
Suite 500
ALEXANDRIA, VA 22314

EXAMINER

PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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07/15/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/629,788	Applicant(s) TAYLOR ET AL.	
	Examiner Pedro Philogene	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 16-20, 23, 24 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 16-20, 23, 24, 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: The specification is objected to for failure to include cross reference to the continuation of the reissue application 11/354,321, per MPEP 1451. Appropriate correction is required.

Priority

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/445,176 or/and PCT/FR98/01119, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. It is noted that in the original oath applicant states that one limitation of original claim1 is not supported by their priority document. Since claim 1 is still pending and this limitation is still in the claim; that means it would be examined WITHOUT the benefit of their earlier priority date.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment made to claims 1 and 3 appears to contain new matter. Claims 1 and 3 were similarly amended from reciting the ball and cup have respective centers of rotation separated by distances to instead recite that the ball exterior surface of the head have respective centers of rotation separated by distance S. the specification only discloses this relationship for the ball and cup; nothing in the original patent disclosure supports the amendment. Therefore, claims 1 and 13 and their dependents are rejected as containing new matter. Note that applicant cannot fix this by adding the same new matter to the specification; the support must be in the patent disclosure.

Claims 1-13 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

the ball and exterior surface of the head have respective centers of rotation separated by distance S.

Reissue Applications

The amendment filed 11/10/08 proposes amendments to the claims that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.

The amendment filed 11/10/08 is non-compliant because applicant provides a listing off the status of the claims which includes claims 21 and 25 as pending even though claims 21 and 25 were cancelled along with claim 15 in the amendment filed 6/20/07.

Furthermore, “applicant is strongly encouraged to submit a full and complete listing of the text of all claims as currently pending to ensure the correct version of each claim is printed should the case become allowed.”

Claims 16-20, 23, 24, 26-30 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application. The limitation omitted in the reissue claims was added in the original application (at least to claim 25) for the purpose of making the application claims allowable over a rejection or objection made in the application. Even though applicant made no argument on the record that the limitation was added to obviate the rejection, the nature of the addition to the claim can show that the limitation was added in direct reply to the rejection. This establishes that the omitted limitation as relating to subject matter previously surrendered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Altarac et al. (7,163,538) see priority above.

With respect to claims 1 and 13, Altarac et al disclose a spinal osteosynthesis device (10) comprising at least two bone anchoring elements (12, 12') for anchoring in respective bodies of the bone structure of the spine, at least one member (20) for longitudinally connecting the bone-anchoring elements, and shakles (40) for connecting the bone anchoring elements together, each bone anchoring element comprises a head (18) for grasping with a screw tool, as best seen in FIG.2, a threaded shank (57) extending the head for grasping, and a tightening element (50) which can be fitted onto the this shank to immobilized the assembly comprising the connector the assembly comprising the connector shakles, the longitudinal connecting emeber and the corresponding anchoring element, characterized in that the threaded shank (57) has a ball end (23) for articulation in a housing (opening) as set forth in column 3, line 37; of a spherical cup of the head for grasping, allowing the shank to be oriented in many directions, and allowing the connecting shackle to be positioned to suit the configuration of the vertebral segment receiving the bone anchoring element, as set forth in column 3, lines 25-67, and in that the ball and the cup have respective centers of rotation (r_1, r_2) which are separated by a distance S, giving the device, when tightening using the

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tightening element (50) by bearing against the spherical cup of the head for grasping, a function or returning the bone anchoring element by transverse force, the connector shakles for this purpose having a spherical bearing surface articulated to a portion of the spherical surface of the cup of the head of the bone anchoring element; as set forth in column 4, lines 1-45.

With respect to claims 2-12, Altarac et al disclose all the limitations, as set forth in column 3, lines 25-67, column 4, lines 1-47; and as best seen in FIGS. 1-5.

Response to Amendment

Applicant's arguments with respect to claims 1-13, 16-20, 23, 24, 26-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,304,179	4-1994	Wagner
5,591,166	1-1997	Bernhardt et al
5,891,145	4-1999	Morrison et al
5,984,924	11-1999	Asher et al.
6,022,350	2-2000	Ganem
6,123,706	9-2000	Lange

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-

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4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/
Primary Examiner, Art Unit 3733
July 13, 2009

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